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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/811,041

03/26/2004

Kazuya Matsumoto

17575

9537

23389

7590

10/02/2006

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EXAMINER

SMITH, PHILIP ROBERT

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

NIT

Office Action Summary	Application No.		Applicant(s)	
	10/811,041		MATSUMOTO ET AL.	
	Examiner		Art Unit	
	Philip R. Smith		3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

- [01] A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/5/2006 has been entered.

Claim Rejections - 35 USC § 103

- [02] The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
- [03] Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda (5,681,260) in view of Biglieri (6,958,577), for the reasons set forth in the Office action of 11/10/2005 with regard to claim 9.

Additional Claim Rejections - 35 USC § 103

- [04] Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda (5,681,260) in view of Biglieri (6,958,577) and in further view of Ben-Haim (6,788,967).
- [05] With regard to claim 1: Ueda discloses a capsule endoscope system comprising:
- [05a] a capsule endoscope ("capsule type endoscope 150," 18/8), of which movement is controlled by a magnetic field externally applied (via "guided

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part 159," 18/50);

[05b] magnetic-field generating means ("magnetic force generating part 31," 18/45) for generating a magnetic field focused on one point to control the movement of the capsule endoscope traveling in a body cavity of a subject lying down on an examination table ("bed 10," 8/42-50); and

[05c] moving means for moving ("magnetic force generating apparatus 11," 8/51-65) the magnetic-field generating means relative to the examination table.

[05d] a magnetic-field generating member ("guided part 159," 18/50) is arranged in at least one portion of the capsule endoscope.

[06] Ueda does not disclose moving means for moving the examination table relative to the magnetic-field generating means.

[06a] Biglieri discloses the following in 5/23-30:

According to a further embodiment of FIG. 6, a magnetic structure may be provided which is displaced relative to the patient table, hence to the body under examination or the part thereof to a predetermined extent and in predetermined directions.

In this case, the magnetic structure 1 or the patient table 2, or both may be displaced relative to each other.

[06b] Biglieri demonstrates the equivalence of the claimed invention with the invention disclosed by Ueda. At the time of the invention, it would have been obvious to a person of ordinary skill in the art that the examination table disclosed by Ueda could be moved relative to the magnetic-field generating means disclosed by Ueda, as opposed to the other way around. A skilled artisan may turn to this obvious and equivalent alternative if, for

example, the magnets (due to their weight) are more difficult to move than the patient; or if the wires associated with an electromagnetic field-generating device are short or cumbersome.

[07] Ueda in view of Biglieri does not disclose that the magnetic field generating member ("guided part 159," as noted above) includes a plurality of magnetic coils arranged in the directions of three axes.

[07a] Ben-Haim discloses a plurality of magnetic coils arranged in the directions of three axes, which perpendicularly intersect one another ("three sensor coils 30, 32 and 34 ... the coils have mutually orthogonal axes," 9/54-67).

[07b] At the time of the invention, it would have been obvious to a person of ordinary skill in the art to substitute the monolithic "guided part 159" disclosed by Ueda with the orthogonal coils disclosed by Ben-Haim. A skilled artisan would be motivated to do so in order to "improve the accuracy and reliability of the position measurement" (10/20-22).

[07c] Ben-Haim discloses that a current may be selectively supplied to at least one of the magnetic coils in a time series manner: "The magnetic fields are distinguishable with regard to the frequency, phase, or both frequency and phase of the signals in the respective magnetic fields. Time multiplexing is also possible." (9/39-42).

Response to Arguments

[08] Applicant's arguments filed 9/5/2006 have been fully considered but they are not

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persuasive.

[09] Applicant's arguments with regard to claim 1 are moot in view of the new grounds of rejection.

[10] With regard to claim 8, Applicant contends that "[w]hen the magnetic force is applied [as recited in claim 8], the capsule endoscope is moved or the power is generated. On the other hand, when the magnetic force is not applied, the position can be detected by the function of the magnetic coils of the capsule endoscope itself ... In contrast, Ueda discloses an electromagnet and a magnetic field that merely ceases to exist by cutting off a current thereto." It is not clear how the claim 8, as characterized by the Applicant, distinguishes itself from Ueda, as characterized by the Applicant. A "magnetic field that merely ceases to exist," as Applicant attributes to Ueda, anticipates a "magnetic force not applied," as attributed to claim 8.

[11] Regardless of Applicant's characterizations, the recited subject matter is unpatentable over Ueda in view of Biglieri, for the reasons set forth in the Office action of 11/10/2005. Ueda discloses a controllable magnetic field which is inherently capable of being "intermittently applied."

Conclusion

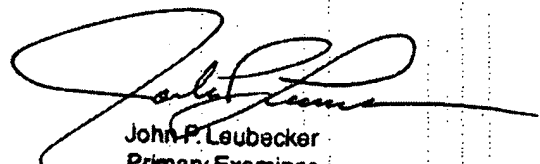
[12] Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip R. Smith whose telephone number is (571) 272 6087 and whose email address is philip.smith@uspto.gov. The examiner can

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normally be reached between 9:00am and 5:00pm.

[13] If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272 4764.

[14] Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to be 'A. S. H.' or similar, located on the left side of the page.A handwritten signature in black ink, appearing to be 'John P. Leubecker', located on the right side of the page.

John P. Leubecker
Primary Examiner